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PATENT

Customer No. 22,852  
Attorney Docket No. 08702.0080-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
Beatriz M. Carreno et al. )  
Serial No.: 09/772,103 )  
Filed: January 26, 2001 )  
For: ANTIBODIES AGAINST CTLA4 AND )  
USES THEREOF )  
)  
)  
)

Group Art: 1644

Examiner: P. Gambel

TECH CENTER 1600/2900

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Commissioner for Patents  
Washington, D.C. 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action dated March 12, 2002, (Office Action), reconsideration of this application in view of the following remarks is respectfully requested. Claims 1-23 are pending in this application. In the Office Action, the Examiner required restriction under 35 U.S.C. § 121 between the following groups of claims:

**Group I:** Claims 1-15 drawn to specific CTLA-4 antibodies and antibody-toxic moieties classified in Class 530, subclass 387.1 and 391.1; and

**Group II:** Claims 16, 17 21 and 22, drawn to a method of modulating/upregulating an immune response with CTLA-4 specific antibodies and antibody toxic moieties, classified in Class 424, subclass 130.1 and 178.1

**Group III:** Claims 16-23, drawn to a method of modulating/downregulating an immune response with CTLA-4 specific antibodies and antibody toxic moieties, classified in Class 424, subclass 130.1 and 178.1

The restriction requirement is respectfully traversed. However, to be fully responsive to the restriction requirement, Applicants elect, with traverse, the subject matter of Group I, claims 1-15.

In the Office Action, the Examiner failed to indicate the reason why the joint examination of claims from Groups I, II and III would be a serious burden, other than to mention that the inventions are distinct. The Examiner's attention is respectfully directed to M.P.E.P. § 803, which sets forth criteria and guidelines for the Examiner to follow in making a proper requirement for restriction. The M.P.E.P. instructs the Office as follows:

If the search and examination of an entire application can be made without **serious** burden, the Office must examine it on the merits, **even though it includes claims to distinct or independent inventions.**

M.P.E.P. § 803 (emphasis added).

Applicants traverse the restriction requirement on the grounds that the Examiner has not shown that there would be a **serious** burden to examine Groups I, II and III together, despite the statement that a prior art search of these groups includes different areas of classification. In fact groups II and III do not even include different areas of classification. Applicants submit that a joint search of Groups I, II and III would not be burdensome as all of the claims of Groups II and III depend on claim 1 (part of Group I)

and therefore contain subject matter whose proper search would overlap with the search of Group I.

Furthermore, Applicants refer the Examiner to various examples of recently issued U.S. patents in which product claims were examined together with method-of-use claims. For instance, U.S. Patent No. 5,760,019, dated June 2, 1998, discloses compounds and compositions inhibiting protease enzymes (claims 1-5), along with methods of inhibiting and methods of treating pathological conditions associated with said protease enzymes (claims 6-18). Moreover, U.S. Patent No. 6,087,304, dated July 11, 2000, discloses compounds and compositions suitable as antiarrhythmic pharmaceuticals (claims 1-19), and their use in methods of treating infarct, angina pectoris and related conditions (claims 20-30). One more example includes U.S. Patent No. 6,150,379, dated November 21, 2000, which discloses factor Xa inhibitors (claims 1-5), and a method of treating conditions associated with factor Xa activity (claim 6). These randomly selected examples clearly indicate that, in the recent past, the Office has not considered the joint examination of claims drawn to products and their methods of use to be a serious burden.

In view of the foregoing remarks, Applicants submit that the Examiner has not established a *prima facie* case of serious burden of search. Accordingly, Applicants respectfully request that the restriction requirement be withdrawn.

Please grant any extensions of time required to enter this response and charge  
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Date: April 18, 2002

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